

### **REMARKS**

Claims 1-14 are pending.

Claims 1-14 stand rejected.

Claim 6 has been canceled, without prejudice.

Claims 1-5, 7-9 and 12-14 have been amended. Support for these amendments can be found throughout the specification and drawings, as originally filed.

This response is submitted in response to a Final Office Action and is deemed to place the application in a condition for allowance, or alternatively, in better condition for appeal.

### **35 USC §112, FIRST PARAGRAPH, REJECTION**

Claims 1-5, 7-9 and 12-14 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The Applicants respectfully traverse the 35 U.S.C. §112, first paragraph, rejection of claims 1-5, 7-9 and 12-14.

In the interests of expediting prosecution of the instant application, and without admission that any amendment is required, the Applicants have amended the relevant claims to substitute the term “peg” for the term “pin.” There is ample support throughout the specification for referring to the two members extending from the distal portion of handle 14 as pegs 26, 28, respectively, as opposed to receptacles (e.g., see Figs. 1-6; page 5, lines 21-29; page 6, lines 5-31; and page 7, lines 1-13). The Applicant would like to remind the Examiner that the original priority application was prepared in German, and it is of course foreseeable that certain phraseology, syntax, and/or grammar particular to the German language may not “translate” well into English, and vice versa. Furthermore, it

is well settled law that the applicant is entitled to be their own lexicographer. Clearly, if nothing else, the drawings make it abundantly clear that the pegs 26, 28 *protrude outwardly* from the handle 14 and are intended to be *received within* the holes 50, 56 of either of the bone plates, not vice verse.

Accordingly, the Applicants contend that the 35 U.S.C. 112, first paragraph, rejection of claims 1-5, 7-9 and 12-14 has been overcome.

### **35 USC §102(b) REJECTION**

Claims 1-8 and 12-14 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,960,147 to Murray.

The Applicants respectfully traverse the 35 U.S.C. §102(b) rejection of claims 1-8 and 12-14. Dependent claim 6 has been canceled, without prejudice and the subject matter thereof substantially incorporated into independent claim 1.

The law is clear that anticipation requires that the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. 35 U.S.C. 102(b).

The law is also clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. 112, fourth paragraph.

In the interests of expediting prosecution of the instant application, and without admission that any amendment is required, the Applicants have amended claim 1 to recite, among other things, bending pliers for perforated bone plates, comprising: (1) two

jaws movable relative to one another, *including a receiving jaw having two spaced-apart peg members at a fixed distance to one another* with an axial extent for insertion through holes of a substantially planar bone plate to be received, the peg members having an outside diameter which is variable along their axial extent in order to cooperate with different hole types; and (2) *a pressure-exerting jaw comprising a pressure-exerting element which, when the bending pliers are actuated, cooperates with a received bone plate in a region between the two peg members, wherein the pressure-exerting element is of a substantially peg-shaped design.*

In the interests of expediting prosecution of the instant application, and without admission that any amendment is required, the Applicants have amended claim 12 to recite, among other things, bending-pliers with jaws that are moveable relative to one another, comprising: (1) *a first jaw having two spaced-apart peg members at a fixed distance to one another*, for insertion through holes of a substantially planar bone plate to be received, the peg members each having a free end and an outside diameter that increases starting from the free end; and (2) a second jaw supporting *a counter-bearing element that cooperates upon actuation of the bending pliers with a received bone plate in a region between the two peg members of the first jaw, wherein the counter-bearing element is of a substantially peg-shaped design*; wherein the first and second jaws are moveable relative to one another.

Murray does not teach the invention as claimed in independent claims 1 or 12, or the claims dependent therefrom.

Specifically, Murray discloses a tool for compressing a highly corrugated staple to join two bone fragments together. Transverse fingers 22 and 23 engage corrugations

16 and 17. However, it is difficult to discern the exact nature in which these components engage one another. There is no discussion that the fingers extend through holes formed in the staple or whether an end portion of the fingers is bent (e.g., as a 90 degree angle) to engage the underside of the corrugations. Thus, there is no teaching by Murray of “a receiving jaw having two spaced-apart pin members at a fixed distance to one another with an axial extent for insertion through holes of a substantially planar bone plate.” Additionally, Murray is completely silent with respect to teaching a second jaw having a pressure-exerting or counter-bearing element that includes a substantially peg-shaped design. The Examiner can only point to a supposed “pressure point,” and can not discern any structure corresponding to the aforementioned second jaw having a pressure-exerting or counter-bearing element that includes a substantially peg-shaped design, *wherein the pressure-exerting or counter-bearing element cooperates upon actuation of the bending pliers with a received bone plate in a region between the two peg members of the first jaw*. Furthermore, Murray teaches the manipulation of a highly corrugated staple, as opposed to “a substantially planar bone plate,” as presently claimed. Thus, Murray does not appear to anticipate independent claims 1 or 12, as amended, or the claims dependent therefrom.

Because claim 1 is allowable over Murray for at least the reasons stated above, claims 2-5, 7 and 8, which depend from and further define claim 1, are likewise allowable. Additionally, because claim 12 is allowable over Murray for at least the reasons stated above, claims 13 and 14, which depend from and further define claim 12, are likewise allowable.

Accordingly, the Applicants contend that the 35 U.S.C. 102(b) rejection of claims

1-8 and 12-14 has been overcome.

Additionally, the Applicants contend that Murray does not render claims 1-5, 7, 8 and 12-14 obvious.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

As previously noted, Murray discloses a tool for compressing a highly corrugated staple to join two bone fragments together. Specifically, Murray discloses a tool for compressing a highly corrugated staple to join two bone fragments together. Transverse fingers 22 and 23 engage corrugations 16 and 17. However, it is difficult to discern the exact nature in which these components engage one another. There is no discussion that

the fingers extend through holes formed in the staple or whether an end portion of the fingers is bent (e.g., as a 90 degree angle) to engage the underside of the corrugations. Thus, there is no disclosure or suggestion by Murray of “a receiving jaw having two spaced-apart pin members at a fixed distance to one another with an axial extent for insertion through holes of a substantially planar bone plate.” Additionally, Murray is completely silent with respect to disclosing or suggesting a second jaw having a pressure-exerting or counter-bearing element that includes a substantially peg-shaped design. The Examiner can only point to a supposed “pressure point,” and can not discern any structure corresponding to the aforementioned second jaw having a pressure-exerting or counter-bearing element that includes a substantially peg-shaped design, *wherein the pressure-exerting or counter-bearing element cooperates upon actuation of the bending pliers with a received bone plate in a region between the two peg members of the first jaw*. Furthermore, Murray discloses the manipulation of a highly corrugated staple, as opposed to “a substantially planar bone plate,” as presently claimed. Additionally, it should be noted that the bending pliers of the present invention include three elements cooperating with the bone plate, namely, two peg members and a pressure-exerting or counter-bearing element. Murray does not appear to disclose a pressure-exerting or counter-bearing element, contrary to the Examiner’s assertion. Thus, one of ordinary skill in the art would not look to Murray for guidance on bending pliers, as presently claimed.

Thus, Murray does not appear to render independent claims 1 or 12 obvious, as amended, or the claims dependent therefrom.

### **35 USC §103(a) REJECTION**

Claims 9-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,960,147 to Murray in view of U.S. Patent No. 6,960,211 to Pfefferle et.al..

The Applicants respectfully traverse the 35 U.S.C. §103(a) rejection of claims 9-11.

In the interests of expediting prosecution of the instant application, and without admission that any amendment is required, the Applicants have amended claim 9 to recite, among other things, a bending-pliers system comprising: (1) bending pliers having two jaws movable relative to one another, including *a receiving jaw having two spaced-apart peg members at a fixed distance to one another* with an axial extent for insertion through holes of a substantially planar bone plate to be received, (2) a pressure-exerting jaw comprising a pressure-exerting element which, when the bending pliers are actuated, cooperates with a received bone plate in a region between the two peg members, the peg members having an outside diameter which is variable along their axial extent in order to cooperate with different hole types, *wherein the pressure-exerting element is of a substantially peg-shaped design*; and (3) at least two types of substantially planar bone plates, each with a different hole type, or a substantially planar bone plate with holes of different types.

Neither Murray and/or Pfefferle et al., either alone or in combination therewith, disclose or suggest the invention as claimed in independent claim 9 or the claims dependent therefrom.

As previously noted, Murray discloses a tool for compressing a highly corrugated staple to join two bone fragments together. Specifically, Murray discloses a tool for compressing a highly corrugated staple to join two bone fragments together. Transverse fingers 22 and 23 engage corrugations 16 and 17. However, it is difficult to discern the exact nature in which these components engage one another. There is no discussion that the fingers extend through holes formed in the staple or whether an end portion of the fingers is bent (e.g., as a 90 degree angle) to engage the underside of the corrugations. Thus, there is no disclosure or suggestion by Murray of “a receiving jaw having two spaced-apart pin members at a fixed distance to one another with an axial extent for insertion through holes of a substantially planar bone plate.” Additionally, Murray is completely silent with respect to disclosing or suggesting a second jaw having a pressure-exerting or counter-bearing element that includes a substantially peg-shaped design. The Examiner can only point to a supposed “pressure point,” and can not discern any structure corresponding to the aforementioned second jaw having a pressure-exerting or counter-bearing element that includes a substantially peg-shaped design, *wherein the pressure-exerting or counter-bearing element cooperates upon actuation of the bending pliers with a received bone plate in a region between the two peg members of the first jaw*. Furthermore, Murray discloses the manipulation of a highly corrugated staple, as opposed to “a substantially planar bone plate,” as presently claimed. Additionally, it should be noted that the bending pliers of the present invention include three elements cooperating with the bone plate, namely, two peg members and a pressure-exerting or counter-bearing element. Murray does not appear to disclose a pressure-exerting or counter-bearing element, contrary to the Examiner’s assertion.



The recitation of Pfefferle et al. does not cure the deficiencies in the teachings of Murray.

Specifically, while Pfefferle et al. may arguably disclose a bone plate with different sized or shaped holes, it does not disclose or suggest a bending-pliers system including “a receiving jaw having two spaced-apart pin members at a fixed distance to one another with an axial extent for insertion through holes of a substantially planar bone plate,” as presently claimed. Thus, Murray and/or Pfefferle et al., either alone or in combination therewith, does not appear to render obvious independent claim 9, as amended, or the claims dependent therefrom.

Thus, one of ordinary skill in the art would not look to Murray and/or Pfefferle et al. either alone or in combination therewith, for guidance on a bending pliers system, as presently claimed.

Because claim 9 is allowable over Murray and/or Pfefferle et al. either alone or in combination therewith, for at least the reasons stated above, claims 10 and 11, which depend from and further define claim 9, are likewise allowable.

Accordingly, the Applicants contend that the 35 U.S.C. 103(a) rejection of claims 9-11 has been overcome.

## **CONCLUSION**

In view of the foregoing, the Applicant respectfully requests reconsideration and reexamination of the Application. The Applicant respectfully submits that each item raised by Examiner in the Final Office Action of July 2, 2007 has been successfully traversed, overcome or rendered moot by this response. The Applicant respectfully submits that each of the claims in this Application is in condition for allowance and such allowance is earnestly solicited.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 723-0487 if any unresolved matters remain.

Any needed extension of time is hereby requested with the filing of this document.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 08-2789.

Respectfully submitted,

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**August 10, 2007**

**Date**

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